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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,140	03/27/2001	Kim C. Smith	450.189US3	3069

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GATEWAY, INC.  
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EXAMINER
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NGUYEN, CAO H

ART UNIT	PAPER NUMBER
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2173

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DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/818,140

Applicant(s)  
Smith

Examiner  
Cao (Kevin) Nguyen

Art Unit  
2173



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 27, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-77 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Specification*

1. Claims 25-27 are objected to because of the following informalities:

The examiner request that the applicant, during the normal review and/or rewriting of the claims, take into consideration these editorial comments and make changes as necessary. Claims 25-27 should be depended on Claim 29.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 25-77 are rejected under the judicially created doctrine of double patenting over claims 1-9 of U. S. Patent No. 6,222,531 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A computerized control management system.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

***Claim Rejections--35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al. (US Patent No. 5,850,218) in view of Portuesi (US Patent No. 5,987,509).

Regarding claim 29, Portuesi discloses a computer-readable medium for a computer having, an executable program stored thereon comprising: means for causing the computer to perform a particular functionality (see abstract and col. 4, lines 9-67); and, means for providing a plurality of controls for use with the particular functionality and displayable within a graphical

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user interface (see col. 6, lines 3-42); however, Portuesi fails to explicitly teach the plurality of controls having a first configuration in which at least one of the controls is opaque, and a second. configuration in which at least one of the controls are at least semi-transparent, such that occurrence of a particular event switches the plurality of controls between the first and the second configurations.

LaJoie teaches the plurality of controls having a first configuration in which at least one of the controls is opaque, and a second. configuration in which at least one of the controls are at least semi-transparent, such that occurrence of a particular event switches the plurality of controls between the first and the second configurations. (see col. 23, lines 45-67 and figure 16). It would have been obvious to one of an ordinary skill in the art at the time the invention was made to provide the plurality of controls having a first configuration in which at least one of the controls is opaque, and a second. configuration in which at least one of the controls are at least semi-transparent, such that occurrence of a particular event switches the plurality of controls between the first and the second configurations, as taught by LaJoie to displaying active uniform network resource of Portuesi in order to provide a full service TV system capable of delivering advanced TV services such as channel navigator and an interactive program guide.

Regarding claims 25-28, LaJoie discloses wherein the particular event comprises selection of a particular display in conjunction with a user- controllable pointer within the

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graphical user interface; and further comprising: a processor; and, a computer-readable medium, wherein the at least one computer program is executed from the computer-readable medium by the processor, and the operating environment is provided from the computer-readable medium by the processor (see col. 19, lines 10-67 and figures 6-7).

Regarding claims 30-32, LaJoie discloses wherein the particular event comprises particular positioning of a user-controllable pointer within the graphical user interface relative to at least one of the controls; and wherein the particular event comprises selection of a particular control in conjunction with a user-controllable pointer within the graphical user interface (see col. 18, lines 11-57 and figure 9).

As claims 33-44 are analyzed as previously discussed with respect to claims 27-32 above.

Regarding claims 45, LaJoie discloses wherein the particular functionality of the application code comprises a virtual appliance mimicking a device external to the computer on which the computer program is running (see figures 10-14).

Claim 46 differs from claims 29 and 38 in that "a computerized control management system, comprising: computer coupled to a graphic display and having a user-controllable pointer; an application program operating on the computer; and a control element displayable on the display, wherein the application program is responsive to the control element, and further

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wherein the control element has two or more sets of display characteristics, wherein a first set of display characteristics is substantially opaque and a second set of display characteristics is substantially non-opaque and wherein the set of display characteristics displayed is a function of the distance between the control and the pointer” which read on LaJoie (see col. 26, lines 1-67 and figures 16-19).

Regarding claims 47-49, LaJoie discloses wherein the application program is responsive to a plurality of controls wherein each control is a member of at least one group of controls and all controls in a group are operative at a predetermined point in the execution of the program and are displayed using a first set of display characteristics (see col. 21, lines 15-67).

Claim 50 differs from claims 29, 38 and 46 in that “computerized control management system, comprising: a computer coupled to a display and having a user-controllable pointer; an application program executable on the computer; a control element on the display, wherein the control element is defined by boundaries of the control” which read on LaJoie (see col. 23-24, lines 1-67).

As claims 51-64 are analyzed as previously discussed with respect to claims 27-32 and 45-50 above.

Regarding claims 65, Portuesi discloses a method for controlling a computer, the computer having a display and operating at least one application program responsive to a user-controlled pointer and responsive to actuation of at least one control selected from at least

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one set of controls, wherein at least one control has at least two modes of display wherein each mode includes a. set of display characteristics, and each control has boundaries and a position, the method comprising: executing the application program; displaying one or more sets of controls as a function of the application program; comparing the position of the pointer with the position of at least one control; determining the state of at least one application program; and selecting the mode of at least one set of controls (see col. 5, lines 7-67 and figures 3-4).

As claims 65-77 are analyzed as previously discussed with respect to claims 27-32 and 45-50 above..

6. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 305-9724 for informal or draft communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. Sixth Floor (Receptionist).



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*Inquires*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (703) 305-3972. The examiner can normally be reached on Monday-Friday from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached on (703) 305-3821. The fax number for this group is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

  
CAO (KEVIN) NGUYEN  
PRIMARY EXAMINER

March 19, 2004

